

### ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-21 remain in this application. Claims 9-17 and 19-21 have been allowed. Claim 7 is objected to. Claims 22-38 have been added to claim additional features of the invention.

Applicant notes that previously, claim 1 was amended merely for clarification purposes. The original claim recited that the image pickup optical and the target optical system were "integrated". Adding the phrase "into a single unit" was for clarification purposes only. MPEP §706.07(a) states that "second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is *neither necessitated by applicant's amendment of the claims* nor based on information submitted in an information disclosure statement" (emphasis added). Because the amendment to claim 1 was merely for clarification, and did not raise new issues, the amendment did not necessitate new grounds of rejection and thus the finality of the rejection is improper and the Examiner is requested to withdraw that finality.

Claims 1-6, 8, and 18 were rejected under 35 U.S.C. §102(e) as being anticipated by Cambier *et al.* (U.S. 6,532,298 B1). For the following reasons, the rejection is respectfully traversed.

Claim 1, as amended, recites a "target screen where the target is displayed", an element which was taken from original claim 2, and thus the amendment does not raise new issues. Furthermore, the reference does not teach this element of claim 1.

The Examiner cites a "target screen [sic] 115" in the reference as teaching the cited claim element. However, a close reading of the reference does not disclose any such "target screen". Instead, the reference teaches that the mirror 120 reflects light visible light such a "virtual image 115 [is formed] behind the mirror 120." (col. 5,

lines 30-34; see also col. 5 lines 58-63 describing a different embodiment also using a “virtual image”). Thus, item 115 is not a “target screen” at all, but is an imaginary image that appears because the image of the iris is reflected back toward the user. Thus, the user is merely seeing a reflection of his own iris. There is no discussion of using an actual target screen in the Cambier device. Thus, claim 1, as amended, is patentable over the reference. Claims 2-6 and 8, which depend, directly or indirectly, on claim 1, are thus patentable over the reference for the same reasons as claim 1.

Further, claim 3 recites a “common half mirror” for “guiding the image of the target on the *target screen* to the eye *without reflecting* the image” (emphasis added). As discussed for claim 1, the reference does not teach a target screen. Accordingly, the reference also does not teach any means for guiding the image to the target screen, and thus claim 3 is patentable over the reference for this reason. Furthermore, the reference teaches that the virtual target image is actually a *reflected* image. Accordingly, the reference also does not teach guiding the image to the eye without reflecting the image, and thus claim 3 is patentable over the reference for this reason as well. Claim 4 is patentable over the reference for reasons similar to claim 3.

Claim 5 recites “a screen illuminating section for illuminating the target screen”. As discussed for claim 1, the reference does not teach a target screen. Accordingly, the reference also does not teach any means for illuminating a target screen, and thus claim 5 is patentable over the reference for this reason as well.

Claim 18 recites that “the reference iris information cannot be overwritten”. The Examiner states that this limitation is inherent to the reference because “if the information was overwritten, the information would be lost, and an authorized user would not be recognized.” This statement is not an accurate representation of the reference device.

It is not enough to merely allege that a function or feature is “inherent”. The Examiner must provide *evidence* and or *rationale* to show inherency. MPEP §2112 (emphasis added). The fact that a certain result or characteristic *may* occur or be present in the prior art is *not sufficient* to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir.

1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art) (emphasis added); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it *would be so recognized by persons of ordinary skill*. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See MPEP §2112.

The Examiner's statement does not follow from the reference, and is not inherent in the disclosed device. The fact that iris information can be overwritten would not mean that the device cannot be used for its purpose. For example, it may be that a new user can overwrite the information, creating a new authorized user and eliminating the previous authorized user. In fact, if such a feature as recited in the claim were a feature of the Cambier device, it could defeat the very purpose of the device. The Background discloses that the Cambier device would be useful for limiting vehicle or residence access. However, if the Cambier device could not be updated to erase a prevent a previous owner or user from the database, then it would permit the previous owner to have access, and thus reduce the security in the device, and make sales of the residence or vehicle more difficult. This would clearly undesirable, and thus the feature is not only not inherent, but it would probably be undesirable. More desirable for the stated purpose would be the ability to delete old users and add new ones.

Consequently, the Examiner has failed to show that the cited feature "is *necessarily present*" in the Cambier device, and thus the rejection is improper. Accordingly, claim 18 is patentable over the reference.

Finally, the newly added independent claims each recite limitations that are not found in the reference, and thus are patentable over the reference for at least the reasons discussed below:

New claim 23 recites a "target optical system including a target screen for displaying a target for the eye" and thus is patentable over the reference for at least the same reason as discussed for claim 1.

Further, new claim 23 also recites a "screen illuminating section different from said eye illuminating section for illuminating the target screen" and thus is patentable over the reference for the same reason as claim 5. New claims 24-28, which depend on claim 23, are thus patentable over the reference for at least the same reasons as claim 23. Further, some of new claims 24-28 also contain additional limitations not taught by the reference as discussed above, and thus are patentable over the reference for those reasons as well.

New claims 29 and 35 recite an "eyepiece" for "transmitting the target image to the eye and for transmitting the image of the iris to the image pickup optical system". Because Cambier teaches that the mirror reflects a "virtual target" directly to the eye without the use of any eyepiece, the claims are patentable over the reference. Claims 30-34, which depend, directly or indirectly on claim 29, are thus patentable over the reference for at least the same reason as claim 29. Further, some of new claims 30-34 also contain additional limitations not taught by the reference as discussed above, and thus are patentable over the reference for those reasons as well.

Finally, new claim 36 recites similar limitations as discussed for claim 3, and thus is patentable over the reference for the same reasons as claim 3. New claims 37 and 38, which depend on claim 36, either directly or indirectly, also include additional limitations discussed above as being patentable over the reference, and thus are patentable over the reference for at least those reasons.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance,

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the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 33781.

Respectfully submitted,

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